receiving data from the network based on at least one result of the monitoring step.--.

REMARKS

I. GENERAL

Claims 40 and 60 have been canceled, without prejudice. In particular, the subject matter of these claims has been incorporated into independent claims 38 and 58, respectively. Claims 42, 52 and 53, and claims 62, 72 and 73 have been rewritten in independent form to include the subject matter of previously-submitted independent claims 38 and 58, respectively. Claims 55 and 75 have been amended to depend from amended independent claims 38 and 58, respectively. Accordingly, Applicants assert that the scope of the pending independent claims was in no way narrowed or limited by the above amendments thereto.

Applicants thank the Examiner for granting a personal interview (the "Interview") to Applicants' representative and one of the inventors on December 6, 2000. Pursuant to this Interview and as per instructions and permission from the Examiner, claims 78-83 were added above. These claims are not intended to narrow the scope of the present invention, and are only provided to clarify the subject matter recited therein. Applicants further submit that no new matter has been added.

II. THE OBJECTION TO THE DRAWINGS SHOULD BE WITHDRAWN

The drawings stand objected to because the boxes in Fig. 1 were not labeled. As the Examiner shall ascertain, Applicants enclose herewith, on a separate sheet, the modified Fig. 1, in which the boxes are appropriately labeled in red ink. Accordingly, the objection to the drawings is now moot, and should therefore be withdrawn.

III. THE REJECTION UNDER 35 U.S.C. § 103(a) SHOULD BE WITHDRAWN

Claims 38-77 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,006,218 to Breese et al. (the "Breese Patent"), in view of U.S. Patent No. 5,848,396 to Gerace et al. (the "Gerace Patent"). It is respectfully asserted that pending independent claims 38, 42, 52 and 53, claims 58, 62, 72 and 72, and the claims which depend from these independent claims are in no way taught or suggested by the alleged combination of the Breese Patent and the Gerace Patent.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103, not only must the prior art teach or suggest each element of the claim, the prior art must also suggest combining the elements in the manner contemplated by the claim. *See* Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir.), cert. denied 111 S.Ct. 296 (1990); *see* In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990).

The Breese Patent relates to a method and system for retrieving information and/or processing the retrieved information as a function of a user's estimated knowledge. (See Breese Patent, column 1, lines 8-12). With these method and system, estimates of the probability that the item being searched is already known to the user, or items listed in the search results are known to the user, are generated. (See Id., column 2, lines 25-29). The generated knowledge probability estimates are then used for ranking or re-ranking the search results. In this manner, the method and system of the Breese Patent adjusts or corrects the results of various search engines. This is apparently done by factoring into the search results and the ranking thereof, a consideration of the probability that the user already knows about certain data items. (See Id., column 2, lines 29-36).

As described in the Breese Patent, these method and system can be used when making recommendations to the user in response to a user initiated information request or after monitoring user's actions for a period of time (in order to estimate probabilities and provide recommendations). The monitored actions may involve the user accessing the Internet site. The recommendations or suggestions can be made to the user regarding other Internet sites or data items which may be unknown but interesting to the user. (See Id., column 3, lines 23-31).

The Gerace Patent relates to a computer network method and apparatus for targeting of an appropriate audience based on psychographic or behavioral profiles

of end users. (See Gerace Patent, Abstract) These method and apparatus use a user profiling member 73 to initiate tracking of viewing activity of the new user immediately following login. (See Id., column 5, lines 1-3).

A. CLAIMS 38, 39, 41, 50, 51, 54-56, 58, 59, 61, 70, 71 AND 74-76

Applicants respectfully assert that the Breese Patent and the Gerace Patent, taken alone or in combination, do not teach or suggest an apparatus or method for monitoring information on a network in which **the information on the network is monitored as a function of the predetermined criterion**, and **this information includes at least one event which is used for detecting a change on the network**, as explicitly recited in independent claims 38 and 58. In the Final Office Action, the Examiner alleges that the Breese Patent teaches that "the information includes at least one event which is used for detecting a change on the network", and points to column 8, lines 15-27 of the Breese Patent to support her allegation. (See Final Office Action, page 4, paragraph 9). However, Applicants respectfully assert that neither this section nor any other section of the Breese Patent teaches or suggests that the information monitored on the network includes any mechanism, much less at least one event which is used for monitoring a change on the network.

In addition and as previously discussed, the Breese Patent states that its method and system can be used when making recommendations to the user after

monitoring user's actions for a period of time. (See Breese Patent, column 3, lines 23-26; *emphasis added*). However, the method and system of the Breese Patent only *checks user input to perform a search*, but **does not monitor** any information on the network (See Breese Patent, Fig. 4b, step 222). The search performed by the system and method of the Breese Patent cannot be equated to the monitoring of the information on the network, as recited in Applicants' claimed invention. Accordingly, the Breese Patent (either in these sections or in any other section) does not teach or suggest that the information is monitored on the network, as recited in independent claims 38 and 58. The Gerace Patent does not cure at least the above-described deficiencies of the Breese Patent to teach or suggest Applicants' invention as recited in independent claims 38 and 58.

With respect to claims 39, 41, 50, 51 and 54-56, and claims 59, 61, 70, 71 and 74-76, these claims depend from independent claims 38 and 58, respectively. Thus, the arguments discussed above with respect to independent claims 38 and 58 also apply to claims 39, 41, 50, 51 and 54, and claims 59, 61, 70, 71 and 74.

In addition, with respect to claims 55, 56, 75 and 76, the Examiner admits that neither the Breese Patent nor the Gerace Patent discloses that **at least one event includes an atomic event and/or a combination of events**. However, the Examiner takes an official notice that these features are well known. (See Final Office Action, page 9, first paragraph). Applicants respectfully disagree and traverse this rejection.

Applicants do not believe that these recitations are well known, and the Examiner did not provide any other reference for supporting the basis for this §103(a) rejection. As such, because the Examiner did not establish a *prima facie* case of obviousness for rejecting claims 55, 56, 75 and 76 under 35 U.S.C. § 103(a), Applicants respectfully request the Examiner to withdraw the §103(a) rejection of these claims or provide another reference or an affidavit for support of the rejection. See 37 C.F.R. § 104(d)(2).

B. CLAIMS 42-49, 57, 62-69 AND 77

Applicants respectfully assert that the Breese Patent provides absolutely no teaching or suggestion that **the information (monitored on the network) includes at least one event and at least one condition**, or that **the predefined criterion (used for monitoring the information) is a rule-based criterion which enables the monitoring operation to monitor for the at least one event on the network and to check if a certain condition of the at least one condition is satisfied**, as explicitly recited in independent claims 42 and 62. In the Final Office Action, the Examiner alleged that the Breese Patent discloses these recitations. In support of this allegation, the Examiner points to column 8, lines 1-42 of the Breese Patent. After reviewing these sections and other sections of the Breese Patent, Applicants respectfully submit that the Breese Patent does not even mention, much less teach or suggest that the information being monitored on the network *includes at least one event and at least one*

condition, as explicitly recited in independent claims 42 and 62. Moreover, the Breese Patent nowhere teaches or suggest that the predetermined criterion used for such monitoring is a rule-based criterion, as also recited in independent claims 42 and 62. Indeed, the Breese Patent nowhere discloses any criterion that is rule-based. In addition for the same reasons as provided above with respect to claims 38 and 58, the Breese Patent does not teach or suggest that the information is monitored on the network, as recited in independent claims 42 and 62. The Gerace Patent does not cure at least these deficiencies of the Breese Patent to teach or suggest Applicants' invention as recited in independent claims 42 and 62.

With respect to claims 43-49 and 57, and claims 63-69 and 77, these claims depend from independent claims 42 and 62, respectively. Thus, the arguments discussed above with respect to independent claims 42 and 62 also apply to claims 43-49 and 57, and to claims 63-69 and 77.

Furthermore, with respect to claims 43 and 63, the alleged combination of the Breese Patent and the Gerace Patent does not teach or suggest **the use of any probing action**, much less that **such probing action has at least one probing operator**, as recited in these claims. In the Final Office Action, the Examiner takes an official notice that these features are well known. (See Final Office Action, page 6, last paragraph). Applicants respectfully disagree and traverse this rejection. As an initial matter, Applicants do not believe that these recitations are well known. In addition, the

Examiner did not provide any other reference for supporting the basis for this §103(a) rejection. As such, because the Examiner did not establish a *prima facie* case of obviousness for rejecting claims 43 and 63 under 35 U.S.C. § 103(a), Applicants respectfully request the Examiner to withdraw the §103(a) rejection of these claims or provide another reference or an affidavit for support of the rejection. See 37 C.F.R. § 104(d)(2).

With respect to claims 44 and 64, these claims depend from and therefore include all the limitations of claims 43 and 63, respectively. Accordingly, the arguments provided above for claims 43 and 63 apply equally to claims 44 and 64. In addition, the alleged combination of the Breese Patent and the Gerace Patent do not teach or suggest that **the probing operator includes a particular query, a data mining query and/or a further condition which provides the information based on at least one of the WHEN portion and the IF portion**, as explicitly recited in claims 44 and 64. Again, the Examiner takes an official notice that these features are well known. (See Final Office Action, page 7, first two paragraphs). Applicants respectfully disagree and traverse this rejection. Applicants do not believe that these recitations are well known, and the Examiner did not provide any other reference for supporting the basis for this §103(a) rejection. As such, because the Examiner did not establish a *prima facie* case of obviousness for rejecting claims 44 and 64 under 35 U.S.C. § 103(a), Applicants respectfully request the Examiner to withdraw the §103(a) rejection of these claims or

provide another reference or an affidavit for support of the rejection. See 37 C.F.R. § 104(d)(2).

The Gerace Patent does not cure the above-described deficiencies of the Breese Patent, nor does the Examiner contends that it does.

C. CLAIMS 52, 53, 72 AND 73

Applicants respectfully assert that the Breese Patent provides absolutely no teaching or suggestion that **the result of the monitored operation includes a copy of at least one monitored predicate (or of a portion thereof)**, as explicitly recited in independent claims 52, 53, 72 and 73. In the Final Office Action, the Examiner alleged that the Breese Patent discloses this recitation. In support of this allegation, the Examiner points to column 6, lines 48-65 of the Breese Patent. After reviewing these sections and other sections of the Breese Patent, Applicants respectfully submit that the Breese Patent does not even mention, much less teach or suggest that *the result of the monitored operation includes a copy of at least one monitored predicate (or of a portion thereof)*. The Gerace Patent does not cure at least this deficiency of the Breese Patent to teach or suggest Applicants' invention as recited in independent claims 52, 53, 72 and 73.

D. SUMMARY

Accordingly, the alleged combination of the Breese Patent and the Gerace Patent does not teach or suggest the subject matter recited in independent claims 38, 42, 52, 53, 58, 62, 72 and 73, and the claims which depend therefrom. Therefore, an affirmation of patentability is respectfully requested for pending claims 38, 39, 41-59 and 61-77.

III. NEW CLAIMS 78-83

New claims 78-83 are presented to cover further aspects of Applicants' invention, and are added pursuant to the Examiner's agreement. Support for new claims 78-81 can be found throughout the specification and in the drawings. For example, as discussed above, the Breese Patent and the Gerace Patent, taken alone or in combination, do not teach or suggest any monitoring of the information *on the network*. In addition, independent claims 78 and 81 explicitly recite that the information on the network is being **continuously monitored**, and independent claims 82 and 83 recite that the information on the network is being **periodically monitored**, which features that are not taught or suggested by the alleged combination of the Breese Patent and the Gerace Patent. New claims 79 and 81 depend from independent claims 78 and 80, respectively, and therefore include the recitation thereof. Accordingly, for at least the reasons presented above, Applicants respectfully submit that claims 78-83 are

allowable over the alleged combination of the Breese Patent and the Gerace Patent.

IV. CONCLUSION

In light of the foregoing, Applicants respectfully submit that pending claims 38, 39, 41-59 and 61-83 are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

Dated: 11 January 2001

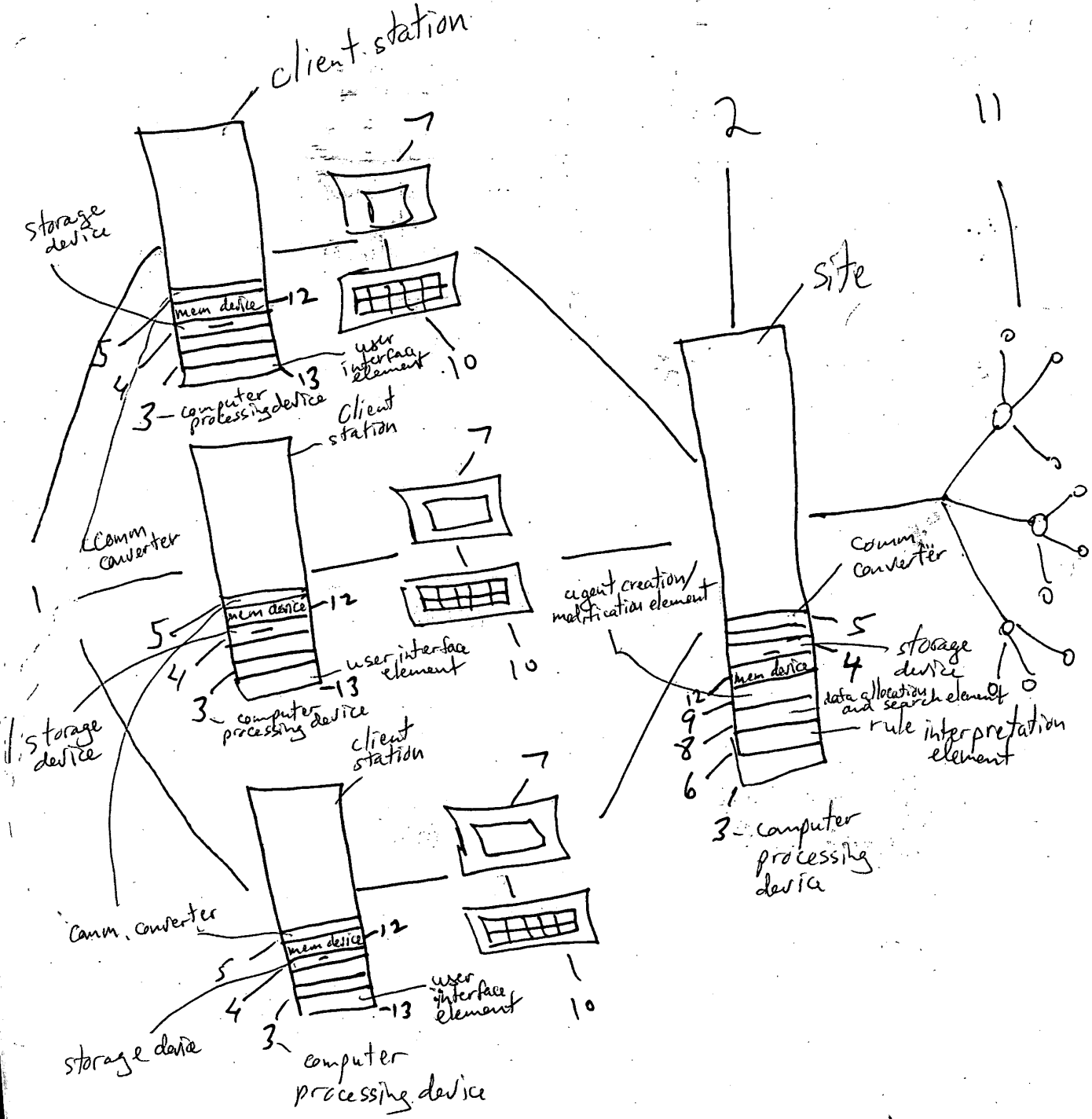
By: _____

Gary Abelev
Reg. No. 40,479

Attorney for Applicant(s)

BAKER BOTTS L.L.P.
30 Rockefeller Plaza, 44th floor
New York, New York 10112-0228
(212) 408-2522

Fig 1


client station
storage device
mem device
12
5
4
3 computer processing device
13
user interface element
10
7
Client station
Comm converter
1
storage device
client station
Comm. converter
storage device
3 computer processing device
2
site
11
Comm converter
agent creation/ modification element
5
storage device
4
data allocation and search element
mem device
12
9
8
6
rule interpretation element
3 computer processing device